

### **REMARKS**

Reconsideration of the January 28, 2005 Office Action is respectfully solicited.

Previously, an Interview Summary was filed concurrently with an INFORMATION DISCLOSURE STATEMENT, on February 16, 2005. Both papers derived from the personal interview with the Examiner on February 15, 2005.

The Supplemental INFORMATION DISCLOSURE STATEMENT [filed concurrently with this paper] presents an article, a portion of which is in German and portions of which are in the English language; the article relates to the problems of carburization.

Applicants respectfully traverse the rejection of claims 37 and 38, although the exact rejection is rendered moot, by virtue of amendment of the preambles of each of those claims, in accordance the Examiner's helpful observation.

The U.S. Patent and Trademark Office Examiner [hereinafter "U.S. PTO"] has rejected the Claims over Hirooka et al (US 5,330,813) in view of Marantz et al (US 3,989,622) and Milaniak et al (US 5,366,765). Applicants respectfully traverse the grounds of rejection.

There are at least two different disclosures, in Hirooka et al., on which the U.S. PTO may apparently rely: (1) the description of the invention of Hirooka et al. and (2) Comparative Example 1, at column 9. Hirooka et al. does not describe applicants' composition used in applicants' process. Hirooka et al. do not relate to modifying the vapor pressure of boron compounds.

Rather, the Hirooka et al. invention resides in a patch. With respect to the patch, the patch comprises a film and a heat-resistant silicone pressure sensitive . The film element of the patch comprises particulate material and a support. Hirooka indicate that adjuvants may be added to the particulate material. In applicants' view, applicants' recitations of liquid, semi-liquid or paste is antithetical to the patch embodiment including a pressure sensitive adhesive, required by Hirooka et al. [Please see Hirooka et al, column 2, lines 35-40. ] As Hirooka et al note, at column 2, line 66 et seq., " It will be possible to form an anti-carburizing, anti-oxidizing film simply by attaching the film shaped material to a surface of a substrate." In applicants' view, the grounds of rejection falls within Section 2100-131 of MPEP, excerpted below.

Hirooka et al. Comparative Example 1 at column 9 refers to "Ceramic Paint No. 2". The contents of that ceramic paint remain *undescribed, and thus the paint is undescribed*. In carburization tests reported at column, a portion of a steel bar was coated once, another portion was coated twice and a third portion was coated three times with the "Ceramic Paint no. 2." Thus, Hiroka Comparative Example 1 does not enable any person of skill in the art to repeat Example 1 and know that that person is in possession of any subject matter, no less applicants' claimed invention.

The USPTO relies not on Hiroka et al alone, but Hiroka et al in combination with Marantz and Milaniak et al. to reject the claims of the application. Neither of the secondary references make up for the Hirooka et al deficiencies. Applicants are guided by the Manual of Patent Examining Procedure Section 2100-131 [Rev.2, May 2004] in which two of the three headings state:

"FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA FACIE OBVIOUSNESS... THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE"

Marantz alone or taken also with Milaniak et al. does not make up for the deficiencies of Hiroka et al. The U.S. PTO relies (at page 4 of the outstanding Office Action) on Marantz, to assert that, 'Thus one of ordinary skill in the art would have expected the refined versions of talc to have the same effects as the unrefined ore.'

In applicants' view Marantz does not establish 'the refined versions of talc have the same effects as the unrefined ore.' More importantly, the person of ordinary skill in the carburizing art would not, in applicants' view, look to the art relating to kidney dialysis.

Marantz's field of application is artificial kidney dialysis, and for the removal of urea from the blood before recycling the blood. The Marantz method relates to using urease in insoluble form for converting urea present in a liquid (e.g. blood). At column 2 lines 33 et seq, Marantz recites,

The types of material which are known to adsorb the urease in the presence of an aqueous solution and render it insoluble to water are magnesium silicate and aluminum oxide.

And at column 7 lines 37 et seq, recites

The tests of magnesium silicate show that activated magnesium silicate... is more satisfactory in adsorbing urease than talc..It is possible, however,

to select an amount and particle size of magnesium silicate talc so that flow rate ratio to pressure drop is acceptable...

Marantz suggests adsorbing urease in an aqueous environment on a urease retaining material selected from the group comprising aluminum oxide and magnesium silicate and is thereafter insoluble so that when contacted by liquid containing urea, the urea is converted into ammonium carbonate while the urease remains adsorbed on the retaining material.

Accordingly, combination or substitution of Marantz recitations into Hiroka et al. Comparative Example 1 does not result in applicants' claims. Combination of Hiroka Comparative Example 1 designation of Ceramic Paint No. 2 with Marantz requires providing a liquid comprising urea; and treating the liquid with a urease retaining material which is aluminum oxide or magnesium silicate and which has urease absorbed thereon. The literal combination requires inter alia the incorporation of urea and urease[from Marantz] into Hiroka Comparative Example 1.

The PTO alleges, Milaniak is analogous art because it is related to problems addressed by the present invention.

Milaniak et al relates to aqueous slurry coating systems for diffusing "aluminide" protective coating in superalloy articles, particularly on internal passages in superalloy articles. All Milaniak coatings must contain a source of aluminum or the coating is *inoperative for its intended purpose*. The Milaniak et al method comprises providing a slurry of a source of aluminum in particulate form, a ceramic particulate, a halide compound activator and an aqueous base dispersant which includes an organic thickening agent; filling the internal cavity of the article with the slurry; evaporating any

solvent; and heating the filled superalloy article to about 1300 to 2300oF to decompose the organic matrix.

Accordingly, combination or substitution of Milaniak recitations into Hiroka Comparative Example 1 do not result in applicants' claims. Combination of Hiroka Comparative Example designation of Ceramic Paint No. 2 with Milaniak requires Milaniak et al method comprises providing a slurry of a source of aluminum in particulate form, an ceramic particulate, a halide compound activator and an aqueous base dispersant which includes an organic thickening agent; filling the internal cavity of the article with the slurry; evaporating any solvent; and heating the filled superalloy article to about 1300 to 2300°F to decompose the organic matrix. Such a combination, in accordance with Milaniak requires providing a protective aluminide coating to increase the life of the articles by reducing the rate of oxidation and/or corrosion. Please see column 1 lines 5-14 of Milaniak et al. Elimination of the aluminum coating renders the Milaniak et al method inoperative for its intended purpose.

In applicants' view, none of the three applied references describe or suggest, alone or in combination, use of a liquid, semi-liquid or paste as required by applicants' claims.

The secondary references are non-analogous art to Hirooka et al patent. In other words, the secondary references are directed to different fields of endeavor from those of Hiroka et al. While the USPTO combines the references to reject the instant application, applicants' opinion is that nothing in any one of the three references would suggest such a combination to arrive at applicants' invention. To put it in other words, there is no motivation to combine and there is no expectation of success, which can be gleaned from

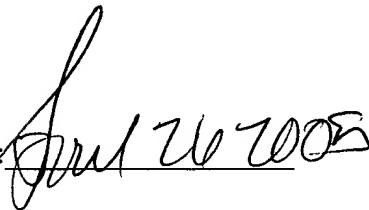
the references themselves. With respect to non-analogous art, one may look to the language of Section 103:

"obvious... to a person having ordinary skill in the art to which said subject matter pertains. "

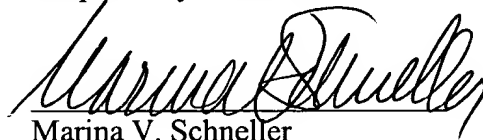
The issue presented by 'non-analogous' art is the other side of the factual determination(s) of 'motivation' or 'expectation of success' . On a factual level the determination(s) relate(s) to whether a person of ordinary skill in the art to which Hirooka et al pertains ---protection of a substrate surface--- would look to the art directed to kidney dialysis [Marantz] or to coatings composition which are used to alter, rather than protect, the surface of superalloy articles [Mianiak et al] to modify the Kirooka et al patch. In applicants' view the person of ordinary skill would not look ot Marantz or to Milaniak to modify Hirooka et al. for any reason.

In summary, none of the references alone or in combination describe or suggest the original claims or the claims presented herein.

Reconsideration and an early allowance are respectfully solicited.

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Respectfully submitted,



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